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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUTZ SCHNEIDEREIT and WOLFGANG WIMMER

Appeal 2009-0844
Application 10/518,843
Technology Center 2600

Decided: March 24, 2009

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand this application to the Examiner to resolve the following issues:

(1) Whether 35 U.S.C. § 112, sixth paragraph has been invoked for claim 8, and if so, whether the means plus function limitations in claim 8 are definite under 35 U.S.C. § 112, second paragraph;

(2) Whether claim 8 recites non-statutory descriptive material under 35 U.S.C. § 101;

(3) Whether claim 1 qualifies as a “process” under 35 U.S.C. § 101; and

(4) Clarify the status of all claims on appeal in light of the Examiner’s decision regarding the above issues.

DISCUSSION

The present application is remanded to the Examiner under 37 C.F.R. §§ 41.35(b) and 41.50. At present, claim 17 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Ans. 4-5). Because claims 1-11, 15, 16, and 19-23 have been allowed and claim 18 has been indicated as containing allowable subject matter if rewritten in independent form (Ans. 3 and 5), we presume that the remaining rejections have been withdrawn.

Claim 8

35 U.S.C. §§ 112, Second and Six Paragraphs

Upon review, the record before us does not clearly indicate whether the Examiner followed the guidelines set forth in MPEP § 2181¹ with respect to claim 8. In particular, the Examiner has not include a statement in an Office Action that any of the limitations in claim 8 are being treated under 35 U.S.C. § 112, six paragraph as set forth in MPEP § 2181(I). MPEP § 2181(I) explains that a claim limitation will be presumed to invoke 35

¹ Manual of Patent Examining Procedure (MPEP), 8th ed., Rev. 6 (Sept. 2007)

U.S.C. § 112, six paragraph if the following three-prong analysis has been met: (1) the claim limitations must use the phrase, “means for;” (2) the “means for” must be modified by functional language; and (3) the phrase “means for” must not be modified by sufficient structure, material, or acts for achieving the specified function. This analysis must be performed on an element-by-element basis to determine if 35 U.S.C. § 112, six paragraph applies.

Additionally, if 35 U.S.C. § 112, six paragraph has been invoked, the Examiner must also decide whether the Appellants have complied with the requirements of 35 U.S.C. § 112, second paragraph as set forth in MPEP § 2181(III). As discussed in this section of the Manual, when 35 U.S.C. § 112, six paragraph has been invoked, the requirements of 35 U.S.C. § 112, second paragraph are complied with if the corresponding structure, material, or acts are described in the Specification in specific terms and an ordinarily skilled artisan could identify the structure, material, or acts from the description. For example, if the Examiner determines that the phrase “determining means for determining the item of start position information” in claim 8 invokes 35 U.S.C. § 112, six paragraph, then the Examiner should determine whether the Appellants have provided sufficient corresponding structure to perform the function of determining the item of start position information in the Specification in specific terms and an ordinarily skilled artisan can identify the structure from the description. As a starting point, the Specification describes a changer module 40 as the mechanism for determining items of start position and that the features of the arrangement, including the determining means for determining the item of start position

information, are provided in a computer software product that comprises software code (Spec. 6:23-24 and 3:18-4:2).

In performing the 35 U.S.C. § 112, second paragraph analysis, the Examiner should also consider two recent cases, *Aristocrat Tech. Australia Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328 (Fed. Cir. 2008) and *Finisar Corp. v. The DirectTV Group*, 523 F.3d 1323 (Fed. Cir. 2008). Both of these cases relate to computer-implemented means-plus-function claim limitations that invoke 35 U.S.C. § 112, sixth paragraph. In *Aristocrat*, the court stated that the corresponding structure in the specification must be more than a general purpose computer or microprocessor with appropriate programming to satisfy the definiteness requirements of 35 U.S.C. § 112, second paragraph. *Id.* at 1333-34. This is because a general purpose computer or microprocessor can be programmed to perform very different tasks and does not limit the scope of the claim to any particular structure that performs the function. *Id.* at 1333. In *Finisar*, the court explained that reciting software without providing some detail about the means to accomplish the function does not adequately disclose the corresponding structure that define the bounds of the invention. *Finisar*, 523 F.3d at 1340-41.

We also note, for every independent claim involved in the appeal, 37 C.F.R. § 41.37(c)(1)(v) requires that “every means plus function . . . as permitted by 35 U.S.C. § 112, sixth paragraph must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.” In the present appeal, for nearly every limitation that includes

“means for” language in claim 8, Appellants refer us to a portion of the Specification that uses the identical language found in claim 8. *See* Br. 3-4 and Spec. 3:18-28. For example, Appellants refer to page three, lines 18 to 28 for support for a “determining means for determining the item of start position information,” a “gating means for generating the identification data block by the gating of part identification blocks,” and a “second generating means for generating a second part identification block form a total for the number of tracks on the data carrier” (Br. 3-4). If 35 U.S.C. § 112, sixth paragraph has been invoked, this disclosure is clearly inadequate to describe the corresponding structures to perform the above-quoted specific functions or to determine the metes and bounds of these limitations.

In summary, we have little guidance from the Examiner or Appellants whether the “means for” limitations in claim 8 have invoked 35 U.S.C. § 112, sixth paragraph, and, if so, whether the means plus function limitations are definite under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 101

The Examiner must additionally consider whether claim 8 recites purely descriptive material that is nonstatutory under 35 U.S.C. § 101. As MPEP § 2106.01 explains, descriptive material can be characterized as either functional or nonfunctional descriptive material. Functional descriptive material includes data structures and computer programs which impart functionality when employed as a computer component, and nonfunctional descriptive material includes a compilation or mere arrangement of data. *See* MPEP § 2106.01. Both of these types of descriptive material can be nonstatutory. *Id.*

Claim 8 recites an arrangement comprising a determining means for determining the item of start position information, a gating means for generating the identification data block by gating of part identification blocks, a first generating means for generating a first part identification block from the items of start position information, and a second generating means for generating a second part identification block from a total for the number of tracks on the data carrier. Along with other discussions (Spec. 6:23-30), the Specification indicates that the arrangement can be a computer software product comprised of software code sections (Spec. 3:8-4:1). If the Examiner determines the arrangement is functional descriptive material, the Examiner must decide whether the material is recorded on some computer-readable medium, such that its functionality is realized, and the claim is, therefore, statutory under § 101. *See* MPEP §§ 2106.01 and 2106.01(I). If not, the Examiner must consider if claim 8 recites purely nonfunctional descriptive material. In this case, even if the descriptive material is recorded on a computer-readable medium, the claim cannot be statutory under 35 U.S.C. § 101. *See* MPEP §§ 2106.01 and 2106.01(II).

Claim 1

Claim 1 recites a method of generating an identification data block by performing an XOR gating operation on items within parts of the data block. Using the analysis under the recent decision, *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008)(en banc), the Examiner must determine whether claim 1 qualifies a “process” under 35 U.S.C. § 101. “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or

thing.” *Id.* at 954. Using this analysis, commonly referred to as the machine-or-transformation test, the Examiner must decide whether claim 1 is tied to a *particular* machine and not just a general purpose computer. *Id.* at 955; *Gottshalk v. Benson*, 409 U.S. 63, 71-72 (1972). If no particular machine has been claimed, the Examiner must also determine whether the claim transforms an article into a different state or thing. *Bilski*, 545 F.3d at 962-63. For example, the court in *Bilski* noted that gathering data would not constitute a transformation of any article as required by the transformation prong of the machine-or-transformation test. *Id.* at 963. Thus, such a step would not transform an article into a different state or thing and would not qualify as a statutory process under 35 U.S.C. § 101.

As such, we remand the case to the Examiner to clarify the record as to whether any of the “means for” limitations in claim 8 invoke 35 U.S.C. § 112, sixth paragraph and whether the Specification provides sufficient corresponding structure, and one skilled in the art could identify the structure to satisfy the definiteness requirement under 35 U.S.C. § 112, second paragraph. To this end, the Examiner may wish to inquire with Appellants regarding the corresponding structure, material, or acts via a Requirement for Information under 37 C.F.R. § 1.105 should further prosecution follow this remand. *See* MPEP §§ 704.10-14.² After determining the scope of claim 8 in light of whether 35 U.S.C. § 112, sixth

² *See also Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1283 (Fed. Cir. 2005) (“The [USPTO] is clearly entitled to use section 1.105 to seek information that may support a rejection. Just as the applicant produces information it deems pertinent to patentability under section 1.56, the examiner is free to request information under section 1.105 that the examiner deems pertinent to the issue of patentability.”).

paragraph has been invoked and determining the corresponding structure for any means-plus-function limitations, the Examiner must then reevaluate patentability of the claims and consider whether claim 8 recites statutory subject matter under 35 U.S.C. § 101. Additionally, the Examiner must consider whether claim 1 recites patent-eligible subject matter under 35 U.S.C. § 101.³

If the Examiner decides to maintain the ground of rejection previously presented in the Answer, then the Examiner must issue a Supplemental Examiner's Answer setting forth such grounds. The Examiner is reminded that *no new grounds of rejection are permitted* in a Supplemental Answer that is responsive to this type of remand. *See* MPEP § 1207.05(C); *see also* MPEP § 1207.05(III).

Therefore, we remand this application to the Examiner to resolve these issues, and if necessary, compel the Appellants under 37 C.F.R. § 1.105 to provide any necessary information.

DECISION

The present application on appeal is remanded to the Examiner for appropriate action in accordance with the foregoing instructions.

Because this application has a “special” status, it requires immediate action. *See* MPEP § 708.01(D). The Board must be informed promptly of any action affecting the appeal in this case.

³ In remanding this case, we have only addressed independent claims 1 and 8. If, however, the Examiner decides that these claims should now be rejected, the Examiner should also address the claims dependent upon claims 1 and 8.

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REMANDED

ELD

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